

REMARKS

Reconsideration and withdrawal of the rejections of the pending claims are respectfully requested in view of the amendments and remarks herein, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-20 are pending in this application. Claims 1-19 have been elected with traverse, and claim 20 has been withdrawn from consideration. Applicants reserve the right to pursue the withdrawn claim in this or future applications.

Claims 1-4, 6-9, and 11-13 have been amended. Claims 4, 6, 7, 9, 11, and 12 have been rewritten as independent claims, and claims 1-4, 6-9, and 11-13 have been amended to overcome objections and rejections set forth by the Examiner in the Office Action.

No new matter has been introduced.

The Examiner is thanked for indicating that claims 4, 6, 7, 9, 11, and 12 would be allowable if rewritten to overcome the objections set forth in the Office Action.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103, or 112. Rather, these amendments are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

The issues raised by the Examiner in the Office Action are addressed below in the order they appear in the prior Action.

II. THE OBJECTIONS TO THE CLAIMS ARE OVERCOME

Claim 13 is objected to under 37 C.F.R. 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. Claim 13 has been amended to recite “or” and not “and/or”. Accordingly, reconsideration and withdrawal of the objection is respectfully requested.

Claim 3 is objected to because it incorrectly depends from claim 7. Claim 3 has been amended to depend from claim 1. Accordingly, reconsideration and withdrawal of the objection is respectfully requested.

III. THE REJECTIONS UNDER 35 U.S.C. § 112 ARE OVERCOME

Claim 8 is rejected under 35 U.S.C. § 112, second paragraph for allegedly failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. The Examiner points out that the recitation of "R⁸ being as defined in claim 6" lacks antecedent basis in claim 2 on which claim 8 is dependent via claim 6. Claim 8 has been amended to recite that R⁸ is defined as in claim 5, which claim recites a definition for R⁸. In view of this amendment, reconsideration and withdrawal of the rejection is respectfully requested.

IV. THE REJECTIONS UNDER 35 U.S.C. § 102 ARE OVERCOME

Rejection of Claims 1, 3, 5, and 10 under

35 U.S.C. § 102(b) as being anticipated by Tice et al. (U.S. Patent No. 6,117,821)

Claims 1, 3, 5, and 10 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Tice et al. (U.S. Patent No. 6,117,821). Applicants traverse this rejection to the extent the rejection is maintained over the claims as amended.

It is respectfully pointed out that a two-prong inquiry must be satisfied in order for a Section 102 rejection to stand. First, the prior art reference must contain all of the elements of the claimed invention. *See Lewmar Marine Inc. v. Bariant Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). Second, the prior art must contain an enabling disclosure. *See Chester v. Miller*, 15 U.S.P.Q.2d 1333, 1336 (Fed. Cir. 1990). A reference contains an enabling disclosure if a person of ordinary skill in the art could have combined the description of the invention in the prior art reference with his own knowledge of the art to have placed himself in possession of the invention. *See In re Donohue*, 226, U.S.P.Q. 619, 621 (Fed. Cir. 1985).

As amended, claim 1 (and by dependency, claims 3, 5, and 10) recites that m is 0. Thus, claims 1, 3, 5, and 10, as amended, recite that the amide nitrogen in compounds of formula (I) bears a sulfide group. Tice et al. pertain to compounds that do not bear a sulfide group on the

amide nitrogen but rather bear a sulfonyl group. As such, Tice et al. do not disclose the compounds recited in the pending claims.

Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 102 is respectfully requested.

Rejection of Claims 1, 3, and 5

under 35 U.S.C. § 102(b) as being anticipated by XP002228063

Claims 1, 3, and 5 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by XP 002228063. The Examiner contends claims 1, 3, and 5 read on the compound having RN 342371-46-4. Applicants traverse this rejection to the extent it is maintained over the claims as amended.

As amended, claim 1 (and by dependency, claims 3 and 5) recite that m is 0. Thus, claims 1, 3, and 5, as amended, recite that the amide nitrogen bears a sulfide group. The compound RN 342371-46-4 does not bear a sulfide group on the amide nitrogen but rather bears a sulfonyl group. As such, XP 002228063 does not disclose the compounds recited in the pending claims.

Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 102 is respectfully requested.

Rejection of Claims 1, 2, 5, 10, and 14-19

under 35 U.S.C. § 102(b) as being anticipated by Yoshida et al., JP 62181261 (1988)

Claims 1, 2, 5, 10, and 14-19 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Yoshida et al., JP 62181261 (1988). Applicants traverse this rejection to the extent it is maintained over the claims as amended.

As amended, claims 1 and 2 (and by dependency, claims 5, 10, and 14-19) recite that m is 0. Thus, claims 1, 2, 5, 10, and 14-19, as amended, recite that the amide nitrogen in compounds of formula (I) (claims 1, 5, 10, 14, 16, and 18) and the imine nitrogen in compounds of formula (II) (claims 2, 15, 17, and 19) bear a sulfide group. Yoshida et al. relate to compounds that do not bear a sulfide group on the amide nitrogen but rather bear a sulfonyl group. As such, Yoshida et al. do not disclose compounds as recited in the pending claims.

Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 102 is respectfully requested.

Rejection of Claims 2, 15, 17, and 19

under 35 U.S.C. § 102(b) as being anticipated by EP 580374

Claims 2, 15, 17, and 19 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by EP 580374. Applicants traverse this rejection to the extent it is maintained over the claims as amended.

As amended, claim 2 (and by dependency, claims 15, 17, and 19) recites that m is 0. Thus, claims 2, 15, 17, and 19, as amended, recite that the imine nitrogen bears a sulfide group. EP 580374 pertains to compounds that do not bear a sulfide group on the amide nitrogen but instead bear a sulfonyl group. As such, EP 580374 does not disclose compounds as recited in the pending claims.

Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 102 is respectfully requested.

For the foregoing reasons, Applicants believe that the references cited by the Examiner do not anticipate the claimed subject matter under 35 U.S.C. § 102. Accordingly, reconsideration and withdrawal of the § 102 rejections is respectfully requested.

V. THE REJECTIONS UNDER 35 U.S.C. §103 ARE OVERCOME

Rejection of Claims 1-2, 5, 10, and 14-19

under 35 U.S.C. § 103(a) as being unpatentable over Mori et al., JP 3-68550

Claims 1-2, 5, 10, and 14-19 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Mori et al., JP 3-68550. Applicants traverse this rejection to the extent it is maintained over the claims as amended.

Establishing a *prima facie* case of obviousness requires three basic criteria: there must be some suggestion or motivation, either in the cited art or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

As discussed above, claims 1 and 2 (and by dependency, claims 5, 10, and 14-19), as amended, recite that m is 0. Thus, claims 1, 2, 5, 10, and 14-19, as amended, recite that the amide nitrogen in compounds of formula (I) (claims 1, 5, 10, 14, 16, and 18) and the imine nitrogen in compounds of formula (II) (claims 2, 15, 17, and 19) bear a sulfide group. Mori et al. relate to compounds that do not bear a sulfide group on the amide nitrogen but rather bear a sulfonyl group. As such, Mori et al. do not teach or suggest all the elements recited in the instant claims.

For the foregoing reasons, Applicants believe that the reference cited by the Examiner does not render the claimed subject matter *prima facie* obvious under 35 U.S.C. § 103(a). Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

VI. ALLOWABLE SUBJECT MATTER

Claims 4, 6-7, 9, 11, and 12 are objected to as being dependent upon a rejected base claim. Applicants note with appreciation that the Examiner has found claims 4, 6-7, 9, 11, and 12 to be allowable if rewritten limited to the examined subgenus (i.e., X is =CH—), in independent form including all the limitations of the base claim and any intervening claims.

Applicants have amended claims 4, 6-7, 9, 11, and 12 to recite that X is =CH— and to be in independent form, including the limitations of the base claim and any intervening claims. Accordingly, the objections to the instant claims are obviated.

REQUEST FOR INTERVIEW

If any issue remains as an impediment to allowance, an interview with the Examiner and SPE is respectfully requested, prior to issuance of any paper other than a Notice of Allowance; and, the Examiner is respectfully requested to contact the undersigned to arrange a mutually convenient time and manner for such an interview.

CONCLUSION

For the reasons stated above, Applicants respectfully request a favorable reconsideration of the application, reconsideration and withdrawal of the rejections of the pending claims, and prompt issuance of a Notice of Allowance.

Respectfully submitted,
MERRIAL LTD.
FROMMER LAWRENCE & HAUG LLP

By:


Judy Jarecki-Black, Ph.D.
Reg. No. 44,170
Tel. No. (678) 638-3805
Fax No. (678) 638-3350

Thomas J. Kowalski
Reg. No. 32,147
Kathleen N. Ehrhard, Ph.D.
Reg. No. 55,144
Tel. No. (212) 588-0800
Fax No. (212) 588-0500